UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,367	07/18/2003	Klaus Abraham-Fuchs	32860-000578/us	4057

7590 01/09/2007		EXAMINER
Alexander Burke, Esq. SIEMENS CORPORATION Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830		WONG, LUT

ART UNIT	PAPER NUMBER
2129	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/621,367	ABRAHAM-FUCHS, KLAUS
	Examiner	**Art Unit**	
	Lut Wong	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 July 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7/11/2005 7/18/2005*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Specification

Abstract

The abstract of the disclosure is objected to because it contains more than 150 words.

Correction is required. See MPEP § 608.01(b).

Disclosure

The disclosure is objected to because of the following informalities: The disclosure

contains many verbose sentences and punctuation errors. For example:

Pg. 2 L21-24: sentence is verbose and confusing.

Pg. 10 L3: change "conditions a and be are satisfied" to "conditions *a* and *b* are

satisfied".

Pg. 3 L30: change "no-one" to "no one".

Appropriate correction is required.

Title

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to because Fig 3 does not show the names for the parts.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "5" has been used to designate evaluation module in both Fig. 1 and Fig. 2. However, these modules are different in terms of structures and functionality. Hence, different reference characters should be used. In additions, reference character "11" in Fig. 1 has been used twice to designate different action paths. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "11", "12", "13". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1, 8, 9, 13, 14, 17, 29, 32, 37, 38, 41, 42 are objected to because of the following informalities:

Claim 1: change "for evaluating of sensitive data" to "for evaluating sensitive data".

Claims 8, 37: change "wherein, after entering the predetermined user identification in the evaluation module, the authorized person is enabled to at least one of add further evaluation options and delete evaluation options" to "wherein the evaluation module is designed such that further evaluation options can be at least one of added and deleted, after entering the predetermined user identification" as recited in claim 23 to make the claim easier to understand.

Claims 9, 38: change "wherein a selection option, from the evaluation options enabled in the evaluation module, is provided by displaying a list of the enabled evaluation options on a monitor" to "wherein the evaluation module is designed to display enabled evaluation options on a monitor" as recited in claim 24 to make the claim easier to understand.

Claims 13, 41: change "wherein at least" to "wherein the at least".

Claim 14: change "the evaluation options include questions" to "the evaluation options are in the form of questions".

Claim 29: change "the evaluation options are questions" to "the evaluation options are in the form of questions".

Claim 1, 17, 32, 42: change the phase "evaluation option which is at least one of inhibitable and enabaleable in the evaluation module by an authorized person" to

"evaluation option, wherein the evaluation option can be inhibited or enabled in the
evaluation module by an authorized person". Examiner Note: There are no such words
as "inhibitable" and "enabaleable".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

**Claims 1-16, 24-29, 30-41,47 are rejected under 35 U.S.C. 112, second paragraph,
as being indefinite for failing to particularly point out and distinctly claim the
subject matter which applicant regards as the invention.**

Claims 1 and 32 recite the limitation "without making the descrambled data accessible
during the evaluation process." in pg. 14 L14-15. It is not clear how to make the
descrambled data inaccessible when the evaluation process is accessing the data for
evaluation. It is contradicting in nature. Hence, the examiner does not know what
applicant is intended to claim. It is presumed that the descrambled data is inaccessible
from other third parties for the purpose of compact prosecution.

Claim 7 recites the limitation "wherein the at least one of inhibiting and enabling of
evaluation options" in pg. 15 L5. There is insufficient antecedent basis for this limitation
in the claim.

Claim 15 recites the limitation "wherein the evaluation options are selected using the
associated expert rules such that they do not allow any conclusion to be drawn from the

evaluation result relating to individual sensitive data items.". Such limitation is contradicting to recited limitation "outputting an evaluation result using the evaluation module" in claim 1. The result itself is already a conclusion about individual's sensitive data. How can the evaluation module disallow conclusion to be made while outputting a conclusion at the same time?

Claims 24-29 recites the limitation "the method as claimed in claim 17" in Line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "the system as claimed in claim 42" in Line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-16, 30-41 are drawn to a method for evaluating sensitive data. The result is outputting an evaluation. There is no practical application claimed using the result. While the practical application does not necessarily need to be recited in the claims, the claims in this instance appear to be directed to a process too preliminary to convey any practical application to one of ordinary skill in the pertinent art.

Claims 17-29, 42-53 are likewise directed to stored instructions for evaluating sensitive data. For the same reasons as above, such claims are not believed to be statutory.

Furthermore, in according to applicant's disclosure, such system can be software per

se. The intrinsic evidence can be found in applicant's disclosure pg. 6 [0024]. Software

is not one of the statutory categories, thus claims drawn to software per se is non-

statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16, 4, 40, 41, 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 recites the limitation "wherein the authorized person is provided with a means

for descrambling the scrambled data." The specification, however, fails to support the

claimed limitation. In fact, the specification clearly states that the evaluation module is

the only means to descramble data. See e.g. [0009]. The specification does not

suggest that the authorized person is provided with an evaluation module to descramble

data. It is presumed to mean the authorized person is provided with a means that can

be used by the evaluation module to descramble data for the purpose of compact

prosecution.

Claims 4, 40, 41, 35 recite the limitation "wherein the sensitive data is scrambled

immediately after its recording, so that it is not accessible in unscrambled form on a

data storage medium". The specification, however, fails to support the claimed

limitation. Specifically, the specification does not show how to make the sensitive data

inaccessible on a storage medium. See e.g. [0021]. Hence, one skilled in the art would

not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

Claims 1-53 are rejected under 35 U.S.C. 102(b) as being anticipated by

NCR INTERNATION INC (EP 0990972 A1. Referred herein as NCR). Examiner

Note (EN) and related citations are denoted in parenthesis.

Claims 1, 32, 17, 42: NCR anticipates a method and system for evaluating of sensitive

data (See e.g. title), comprising: provisioning an evaluation module (See e.g. Fig. 1 the

secure data warehouse 102) for descrambling scrambled and stored sensitive data (EN:

¶1 applies), including at least one predetermined evaluation option (customer's privacy

preferences. See e.g. Fig. 1 and [0019]) which is at least one of inhibitable and

enableable in the evaluation module by an authorized person (preference can be

override. See e.g. [0019]) and to which expert rules (privacy rules. See e.g. Fig. 1 label

152 and [0017]) are allocated for carrying out an evaluation process, to which the

evaluation module has access (See e.g. Fig. 1 102 has access to 150); selecting an

option from evaluation options enabled in the evaluation module for a user (retrieve

privacy preference. See e.g. Fig. 5 step 502); and internally descrambling the

scrambled data, evaluating the descrambled data in accordance with at least one expert

rule associated with the selected evaluation option, and outputting an evaluation result

using the evaluation module (providing data access using privacy rules. See e.g. [0017]

and Fig. 5 step 508), without making the descrambled data accessible during the

evaluation process (See e.g. [0019], especially "third party applications 112 have access only to such

data as permitted by the database view provide").

Claims 2, 18, 33, 43: Note that the evaluation module includes at least one of a key and

an algorithm for reconstruction of a key for descrambling the scrambled data (*EN: this is*

inherent nature of encryption: either asymmetric (using a key) or symmetric (using an

algorithm). See e.g. [0058] regarding data encryption and key code).

Claims 3, 19, 34, 44: Note that the algorithm produces the key as a function of at least

one of an input and of a biometric feature of the authorized person (encryption code.

See e.g. [0058]. *EN: in order to produce a key, there must have an input. Hence, it is*

an inherent nature for decrypting a symmetric key algorithm).

Claims 4, 30, 31, 35: Note that the sensitive data is scrambled immediately after its

recording (data encryption. See e.g. [0057])

Claims 5, 20, 45: Note that the expert rules are implemented in the evaluation module (See e.g. Fig. 10).

Claims 6, 21, 46: Note that the expert rules are stored in a databank, to which the evaluation module has access while carrying out the method (See e.g. Fig. 1).

Claims 7, 22, 36, 47: Note that the at least one of inhibiting and enabling of evaluation options in the evaluation module is permitted only after the authorized person has entered a predetermined user identification (provide access to a verified entity. See e.g. Fig. 6 step 604).

Claims 8, 23, 37, 48: Note that the evaluation module is designed such that further evaluation options can be at least one of added and deleted, after entering the predetermined user identification (See e.g. [0021] especially where it states "the consumer may update or change preferences as desired").

Claims 9, 24, 38, 49: Note that the evaluation module is designed to display enabled evaluation options on a monitor (See e.g. [0021]. *EN: kiosk must have a monitor*)

Claims 10, 25, 50: Note that the evaluation module is designed such that it evaluates the data only after a predetermined access code has been entered (provide access to a verified entity. See e.g. Fig. 6 step 604).

Claim 15: Note that the evaluation options are selected using the associated expert

rules such that they do not allow any conclusion to be drawn from the evaluation result

relating to individual sensitive data items (See [0017] customer privacy preference and

rules. See also e.g. [0019], especially "third party applications 112 have access only to such data as

permitted by the database view provide").

Claim 16: Note that the authorized person is provided with a means that can be used by

the evaluation module to descramble data (See e.g. Fig. 1 smart card 136).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**<u>Claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53), (14, 29) are rejected
under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35
U.S.C. 103(a) as obvious over NCR INTERNATION INC (referred herein as NCR)
and Official Notice. Examiner Note (EN) and related citations are denoted in
parenthesis.</u>**

Claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53): NCR anticipates a server

(See [0021]). It is inherent properties of a server to have a storage medium. *EN: it is*

non functional distinct whether the medium is a common or a separate or a portable

data storage medium. Even if NCR does not anticipates that the scrambled data and

the evaluation module are stored on a common or separate or portable data storage

medium. It would still have been obvious to one of ordinary skill in the art that a server

is capable of storing in any kind of storage medium. The examiner takes official notice

that storing data on a common or separate or portable data storage medium is well

known in the art.

Claims 14, 29: NCR anticipates customer preferences (See e.g. [0021]). The

preference must be presented in the forms of questions. *EN: it is non functional distinct*

whether the options are in the forms of questions or not. Even if NCR does not

anticipates that the evaluation options are in the forms of questions. It would still have

been obvious to one of ordinary skill in the art that preference can be asked in question

form. The examiner takes official notice that presenting options in the form of questions

is well known in the art.

Examiner Note

¶1: The phase "for…" is treated as intended use. Intended use is not a positive

limitation. Hence, a prior art only need the capability to do so.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
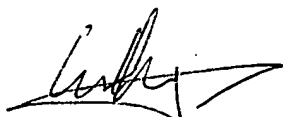
Thomson et al (US 5751949)

Abraham-Fuchs et al (US 20020111741)

Rumpel et al (US 20040153662)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lut Wong

DAVID VINCENT
SUPERVISORY PATENT EXAMINER
1/3/07

Patent Examiner 2129